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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/692,513
Filing Date: October 24, 2003
Appellant(s): HALE ET AL.

John R. Wahl
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/7/2010 appealing from the Office action mailed 5/28/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0122137	Chen et al.	9-2002
2002/0053085	Toguri	2-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22-44 and 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al., US 2002/0122137 in view of Toguri, US 2002/0053085.

Regarding claim 22, Chen discloses a method of providing content data to a viewer of a media presentation in conjunction with the media presentation, comprising:

providing a viewer of the media presentation with a portable device, the portable device being remote from the presentation of the media presentation and capable of receiving wireless communications and displaying content data relating to the media presentation **[TCD 120, Fig. 3, paras. 27, 31, 43]**;

transmitting content data to the portable device **[e.g., paras. 30, 42]**; and

displaying the content data on the portable device **[video output 126 and screen 127, Fig. 3; paras. 30, 43]**.

Chen is silent on storing data in the receiving device before being displayed in response to timing information. Toguri teaches accumulating content data in the cache memory of a terminal device **[AV contents and metadata are transmitted to and stored in terminal apparatus 9; one option is batch (as opposed to real-time) delivery, i.e. the data is stored in advance of presentation, paras. 90, 91, 100]**. Toguri also transmits a time prompt to the portable device, the time prompt triggering the content data to be displayed on the portable device such that the content data is displayed in synchronization with the presentation of a corresponding portion of the media presentation **["reproduction time" or time prompt is used by the terminal to synchronously display metadata corresponding to the media presentation, Fig.S12 and S14, Fig. 2, paras. 20, 21, 93; Fig. 10, paras. 9, 79; terminal integrates, synchronizes, and displays A/V contents (analogous to the claimed "media presentation") with metadata (analogous to the claimed "content data"; para. 149]**.

Although Chen lacks specific disclosure of caching and timing operations, he does teach that the presentation of streams may be executed automatically **[para. 29]**, implying the need for timing information to provide a trigger. Chen also uses event identifiers to select and display auxiliary streams **[paras. 55, 57]**. These synchronization techniques would suggest to one of ordinary skill that a time prompt could also be used to trigger the display of corresponding auxiliary information as taught by Toguri. Therefore, the combination of Chen and Toguri is an obvious in order to synchronize primary content and metadata, for example to display player portraits or statistics at a relevant time in a televised sporting event **[*see* Chen, para. 28]** or to synchronize questions and answers in a play-along trivia game **[*see* Chen, para. 59]**.

Regarding claims 23 and 24, Chen discloses a method wherein the at least one time prompt is transmitted by way of infrared signal or RF signal **[para. 40]**.

Regarding claims 25-32, Toguri discloses a method wherein the media presentation or the content data may comprise graphics, text, video, audio, or a combination of audio and video data **[e.g., Chen Abstract; Toguri paras. 149 and 150]**.

Regarding claim 33, Chen discloses a method wherein the at least one time prompt is representative of a time of day **[TCD selects particular stream at predetermined time of day, para. 30]**.

Regarding claim 34, Chen discloses a method wherein the at least one time prompt is representative of a time at which the media presentation starts **[Toguri, paras. 103, 104, 118-121]**.

Regarding claims 35 and 36, Chen discloses a method wherein the portable device comprises speakers and/or a display **[Fig. 3, para. 43]**.

Regarding claims 37 and 38, Chen does not refer to the mobile device as a "personal digital assistant" or cellular phone. However, the TCD described is comprised of an antenna, transceiver, speaker, and input keys **[*see* Figs. 1, 3]**. Given the component described, a person of ordinary skill would find it obvious that a PDA or cell phone could be used as the portable device. Both devices have the same components as the disclosed TCD and are capable of the same functions. The benefit is that these devices already have the capability to communicate and display data and they are ubiquitous among the public; additional portable devices need not be supplied to viewers that already possessing this type of device. This could allow restaurants, for example, to service more customers with a smaller inventory of "TCDs" per se.

Regarding claim 39, Toguri discloses a method wherein the media presentation is a pre-recorded presentation **[Fig. 21, para. 160]**.

Regarding claim 40, Chen and Toguri disclose a method wherein the pre-recorded presentation is a movie **[Chen paras. 53-56, Toguri paras. 73, 108, 129]**.

Regarding claim 41, Chen discloses a method wherein the pre-recorded presentation is a movie and the content data is text captioning **[closed caption data is an example of auxiliary information that can be provided via TCD rather than TV, para. 10]**.

Regarding claim 42, Chen discloses a method wherein the pre-recorded presentation is a movie and the content data comprises descriptive audio for the blind **[audio data can be presented via TCD, e.g., Chen Abstract; Toguri paras. 149 and 150]**.

Regarding claim 43, Chen discloses a method wherein the content data is a visual narrative, the visual narrative being displayed in one of a plurality of languages **[para. 43]**.

Regarding claim 44, Chen discloses a method wherein the content data is an audio narrative, the audio narrative being played in one of a plurality of languages **[para. 43; e.g., Chen Abstract; Toguri paras. 149 and 150]**.

Regarding claims 58, 61, and 66, Chen discloses a method wherein the media presentation is live **[e.g. a sports broadcast, para. 28]**.

Regarding claim 70, Toguri discloses a method wherein content data is transmitted to the portable device at the start or slightly in advance of the start of the media presentation **[para. 90]**.

Regarding claim 71, Chen discloses a method further providing inputs on the portable device adapted to receive information from the viewer **[inputs 129, 130, Fig. 3]**.

Claims 46-68 and 72-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toguri, US 2002/0053085in view of Chen et al., US 2002/0122137.

Regarding claim 46, Toguri discloses a method of interactive communication during a media presentation, comprising:

presenting the media presentation at a first location using media presentation data, the media presentation data having at least one time code associated with-the media presentation data **[para. 21; time code is "reproduction time" in region 61 of DB21, paras. 100, 101]**;

caching the media presentation data in a memory **[AV contents and metadata are transmitted to and stored in terminal apparatus 9; one option is batch (as opposed to real-time) delivery, i.e. the data is stored in advance of presentation, paras. 90, 91, 100]**;

transmitting the media presentation data to the portable device and while the media presentation is being presented, detecting one of the at least one time code associated with the media presentation data **["reproduction time" or time prompt is used by the terminal to synchronously display metadata corresponding to the media presentation, S12 and S14, Fig. 2, paras. 20, 21, 93; Fig. 10, paras. 9, 79]**;

determining when the media presentation data should be displayed based on the contents of the at least one time code and displaying the media presentation data on the portable device in relative synchronization with the presentation of a corresponding portion of the media presentation **[terminal integrates, synchronizes, and displays A/V contents (analogous to the claimed "media presentation") with metadata (analogous to the claimed "content data"; para. 149]**.

While Toguri does not perform the above functions in connection with a portable device, he does discuss separate display regions for content and metadata **[Fig. 19, para. 149]**. Chen teaches providing a viewer of the media presentation with a portable device, the viewer being located at a second location remote from first location **[TCD 120, Fig. 3, paras. 27, 31, 43]**. Given the separate display regions disclosed by Toguri, it would have been obvious to one of ordinary skill that one of the displays could be integrated in a portable device. The benefits of remote display units include allowing

personalized data to be sent to individuals in a public setting, and enabling parental control of content at home **[*See* Chen, para. 30]**.

Regarding claim 47, Toguri discloses a method of providing content data to a viewer of a media presentation in conjunction with the media presentation, comprising:

transmitting the content data to a terminal using first receiver signals at the start or slightly in advance of the start of the media presentation and accumulating content data in a cache memory of the portable device **[AV contents and metadata are transmitted to and stored in terminal apparatus 9; one option is batch (as opposed to real-time) delivery, i.e. the data is stored in advance of presentation, paras. 90, 91, 100; storage module 108, Fig. 21]**;

transmitting at least one message to the portable device using second receiver signals, the at least one message a time when the content data should be presented on the portable device such that the content data and a corresponding portion of media presentation are displayed in synchronization **["reproduction time" or time prompt is used by the terminal to synchronously display metadata corresponding to the media presentation, S12 and S14, Fig. 2, paras. 20, 21, 93; Fig. 10, paras. 9, 79]**; and

presenting the data on the portable device to the viewer in synchronization with the media presentation **[terminal integrates and synchronizes, and displays A/v contents (analogous to the claimed "media presentation") with metadata (analogous to the claimed "content data"; para. 149]**.

While Toguri does not perform the above functions in connection with a portable device, he does discuss separate display regions for content and metadata **[Fig. 19, para. 149]**. Chen teaches providing a viewer of the media presentation with a portable device, the portable device comprising at least two receivers, the portable device-capable of presenting content data relating to the media presentation to the viewer in conjunction with the media presentation **[TCDs 120, Fig. 3, paras. 27, 31, 43]**. Given the separate display regions disclosed by Toguri, it would have been obvious to one of ordinary skill that one of the displays could be integrated in a portable device. The benefits of remote display units include allowing personalized data to be sent to individuals in a public setting, and enabling parental control of content at home **[*See* Chen, para. 30]**.

Regarding claim 46, Toguri discloses a method of providing content data to a viewer of a media presentation in conjunction with the media presentation, comprising:

transmitting and accumulating content data in the cache memory of the portable device **[AV contents and metadata are transmitted to and stored in terminal apparatus 9; one option is batch (as opposed to real-time) delivery, i.e. the data is stored in advance of presentation, paras. 90, 91, 100]**;

transmitting at least one time prompt to the portable device using second receiver signals, the time prompt identifying a time when the content data should be displayed on the portable device such that the content data and a corresponding portion of media presentation are displayed in synchronization **["reproduction time" or time**

prompt is used by the terminal to synchronously display metadata corresponding to the media presentation, S12 and S14, Fig. 2, paras. 20, 21, 93; Fig. 10, paras. 9, 79]; and

executing the content data on the portable device in synchronization with the media presentation **[terminal integrates, synchronizes, and displays A/V contents (analogous to the claimed "media presentation") with metadata (analogous to the claimed "content data"; para. 149]**..

While Toguri does not perform the above functions in connection with a portable device, he does discuss separate display regions for content and metadata **[Fig. 19, para. 149]**. Chen teaches providing a viewer of the media presentation with a portable device, the portable device comprising at least two receivers, the portable device being capable of displaying content data relating to the media presentation **[TCD 120, Fig. 3, paras. 27, 31, 43]**. Given the separate display regions disclosed by Toguri, it would have been obvious to one of ordinary skill that one of the displays could be integrated in a portable device. The benefits of remote display units include allowing personalized data to be sent to individuals in a public setting, and enabling parental control of content at home **[*See* Chen, para. 30]**.

Regarding claims 49, 55, 60, and 73, Chen discloses a method further providing inputs on the portable device adapted to receive information from the viewer **[inputs 129, 130, Fig. 3]**.

Regarding claims 51 and 77, Chen discloses a method wherein the portable device further comprises at least a transceiver **[e.g., Abstract]**.

Regarding claims 52 and 78, Toguri discloses a method wherein the time prompt further identifies the content data to be presented at the portable device **[e.g., para. 101]**.

Regarding claims 53, 57, 64, 68, 74, 75, and 79, Toguri discloses a method wherein content data is transmitted to the portable device at the start or slightly in advance of the start of the media presentation **[para. 90]**.

Regarding claims 54, 59, 60, and 65, Toguri discloses a method of providing a viewer of a first media content with a second media content, comprising:

transmitting the second media content to the portable device **[AV contents and metadata are transmitted to and stored in terminal apparatus 9; one option is batch (as opposed to real-time) delivery, i.e. the data is stored in advance of presentation, paras. 90, 91, 100; storage module 108, Fig. 21]**;

transmitting a time prompt to the portable device, the time prompt triggering a display of the second media content on the portable device such that the second media content and a portion of the first media content are displayed in synchronization **["reproduction time" or time prompt is used by the terminal to synchronously**

display metadata corresponding to the media presentation, S12 and S14, Fig. 2, paras. 20, 21, 93; Fig. 10, paras. 9, 79]; and

displaying the second media content on the portable device at a time indicated by the time prompt **[terminal integrates and synchronizes, and displays A/v contents (analogous to the claimed "media presentation") with metadata (analogous to the claimed "content data"; para. 149]**.

While Toguri does not perform the above functions in connection with a portable device, he does discuss separate display regions for content and metadata **[Fig. 19, para. 149]**. Chen teaches providing the viewer of the first media content with a portable device, the portable device being remote from a display of the first media content, the portable device being capable of receiving wireless communication and displaying the second media content **[TCDs 120, Fig. 3, paras. 27, 31, 43]**. Given the separate display regions disclosed by Toguri, it would have been obvious to one of ordinary skill that one of the displays could be integrated in a portable device. The benefits of remote display units include allowing personalized data to be sent to individuals in a public setting, and enabling parental control of content at home **[*See* Chen, para. 30]**.

Specifically with respect to claims 60 and 65, Toguri does not show a portable device with inputs. However, the TCD in Chen does provide input means **[inputs 129, 130, Fig. 3]**. It would have been obvious to one skilled in the art to provide user inputs to facilitate selection from the various available streams taught by Toguri **[e.g., paras. 136-138]**.

Regarding claims 56, 62, and 67, Toguri discloses a method further comprising accumulating the second media content in cache memory of the portable device **[AV contents and metadata are transmitted to and stored in terminal apparatus 9; one option is batch (as opposed to real-time) delivery, i.e. the data is stored in advance of presentation, paras. 90, 91, 100; storage module 108, Fig. 21]**.

Regarding claims 58, 61, and 66, Chen discloses a method wherein the first media content is live **[e.g. a sports broadcast, para. 28]**.

Regarding claim 63, Chen discloses a method wherein the second media content is related in content with a portion of the first media content **[e.g., paras. 28, 30]**.

Regarding claim 72, Toguri discloses a method further comprising determining what portion of the media presentation data should be displayed based on the contents of the at least one time code **["reproduction time" or time prompt is used by the terminal to synchronously display metadata corresponding to the media presentation, S12 and S14, Fig. 2, paras. 20, 21, 93; Fig. 10, paras. 9, 79; terminal integrates, synchronizes, and displays A/V contents (analogous to the claimed "media presentation") with metadata (analogous to the claimed "content data"; para. 149]**.

Regarding claims 50 and 76, Chen discloses a method wherein the at least one time prompt is transmitted by way of infrared signal or RF signal **[para. 40]**.

(10) Response to Argument

Appellant first argues that Toguri's "reproduction time" does not meet the recited "time prompt." Rather, the appellant asserts that "reproduction time" as used in Toguri is limited to describing the duration of the media content, and in support cites several sections of Toguri that use the term. However, none of those sections clearly define "reproduction time," aside from paragraph [0102] which provides a logically circular and therefore unhelpful definition. Mostly the term is simply included among other pieces of metadata that are described as "inherent to the common A/V contents among the users" (para. [0017]). This is consistent with a reading of "reproduction time" as a triggering mechanism, since the relative reproduction time of auxiliary content (e.g., 10 minutes after the start of the content) would be the same for all users. Therefore, in the absence of a limiting definition and in the context of presenting related metadata at relevant times during a presentation, Toguri's "reproduction time" could reasonably be interpreted by one skilled in the art as a time prompt that is used to trigger the reproduction of auxiliary data.

Furthermore, even if "reproduction time" was interpreted as a duration of the content, such information would be relevant to the presentation time of auxiliary data. For example, the auxiliary data might be a list of resources with further information on

the presentation topic, displayed at the end of the primary presentation. The duration of the content would determine the display timing of such auxiliary data.

Appellant argues that Toguri is deficient because even if "reproduction time" is interpreted as a time prompt, it is not transmitted to Toguri's terminal output unit 10 and therefore is not transmitted "to the portable device" as recited. However, the rejection does not analogize terminal output unit 10 to the portable device. Rather, the portable device is met by the TCD of Chen, while the synchronization functionality is met by Toguri. In Toguri, the time prompt is transmitted to terminal 9, which is interpreted as part of an overall terminal consisting of terminal input unit 8, terminal 9 (controller), and terminal output unit 10 (display). The rejection reasons that it would have been obvious to combine the functionality of the overall terminal with a portable device such as the TCD of Chen.

Appellant further argues that "reproduction time" is not a functioning element of the system, based on its inclusion with other metadata that may be considered nonfunctional, such as title, genre, etc. However, "reproduction time" is also included among datasets that are clearly functional. For example, database 21 (DB21) stores metadata, intended for transmission to user terminals, including reproduction time, storage location, usage classification, and other information that would typically be used to control the display of the data (Toguri paras. 79, 100, 102; Fig. 12). Reproduction time can therefore reasonably be read to provide synchronization functionality.

Examiner notes that while the pending rejections rely on Toguri's "reproduction time", Toguri's "start position" and "end position" data can also be analogized to the

claimed time prompt. The database 21 stores and transmits these timing values to the terminal, and they clearly would be recognized by one of ordinary skill to have functional value in the synchronization module (Toguri paras. 103, 105; Fig. 12). Examiner believes the reasoning of the rejection is sound whether "reproduction time" or "start time" is analogized to the time prompt.

To summarize, Chen teaches the portable device limitations, and Toguri meets the storage and synchronous display elements as discussed above. While Toguri does not teach separate devices for displaying different data, it does teach separate synchronous displays that are analogous to the application of Chen (*see* Chen, paras. 28, 59). Taken together, the references would suggest to one of ordinary skill that the separate devices in Chen could be operated in concert by a synchronization module taught by Toguri.

The Appellant also traverses whether the rejection could properly be based on inherency. The Examiner maintains that it could (as argued at pp. 2-3 of the final Office Action mailed 5/28/2009), but the rejections themselves do not rely on inherency so the argument is moot for purposes of appeal.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Timothy Newlin, Examiner, Art Unit 2424

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